

Appl. No. : 10/078,282  
Filed : February 19, 2002

### REMARKS

#### Amendments to the Claims

Applicant respectfully requests entry of the Amendments to the Claims set forth above. Claim 10 has been amended to recite certain limitations previously recited in Claim 11, which has now been canceled. Claims 44 and 46 have been amended to correct minor typographical errors. Claims 10 and 40-51 have been amended for clarity to replace the term "mechanism" with the term "component." The amendments to correct typographical errors and improve clarity do not reduce the scope of Claims 10 and 40-51. New Claims 51-54 recite optical compensation mechanisms previously recited in Claim 11. New Claims 55-56 recite optical performance enhancements as supported throughout the specification, e.g., page 16, line 19 continuing to page 19, line 9. Since all of these changes are supported in the originally filed specification, there is no issue of new matter.

Applicant reserves the right to file divisional and/or continuation applications containing claims directed to all or part of the subject matter described in the instant application, including the subject matter of any claims amended, withdrawn, or canceled at any time during the prosecution of this application, and thus unclaimed subject matter is not dedicated to the public.

#### Claim Objections

The Office objects to Claim 46 on the basis that the word "form" should be corrected to read --from--. Applicant regrets this minor typographical error, which has been corrected in the Amendments to the Claims set forth above, and respectfully requests that this objection be withdrawn.

#### Claim Rejections - 35 U.S.C. § 112

Claim 44 has been rejected under 35 U.S.C. § 112, second paragraph, the Office suggesting that Claim 44 should depend from Claim 43 rather than Claim 42. Applicant regrets this minor typographical error, which has been corrected in the Amendments to the Claims set forth above, and respectfully requests that this rejection be withdrawn.

#### Claim Rejections - 35 U.S.C. § 102

Appl. No. : 10/078,282  
Filed : February 19, 2002

Claims 10 and 11 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,293,272 ("Jannson"). The Office has taken the position that Jannson discloses all of the limitations of Claims 10 and 11, including a holographically patterned material as an optical compensation mechanism. Other than the holographically patterned material, Applicant notes that the Office has not alleged that Jannson discloses any other optical compensation mechanism which enhances the optical performance of the structure.

**A. The Law of Anticipation**

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052 (Fed. Cir. 1994). "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 265 F.3d 1349 (Fed. Cir. 2001). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). The Applicant submits that, in light of the Amendments to the Claims, Jannson fails to teach or suggest all of the limitations of Claim 10, as discussed below.

**B. Discussion of Distinctions of the Claims in View of Jannson**

Applicant has amended Claim 10 to recite that the optical compensation mechanism comprises one or more of a photonic crystal array, a multilayer array of dielectric mirrors, or an array of microlenses. Applicant respectfully submits that Claim 10 recites a combination of limitations, including the recited optical compensation mechanism, that is neither taught nor suggested by Jannson. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection.

**Claim Rejections - 35 U.S.C. § 103**

Claims 40 and 46 have been rejected under 35 U.S.C. § 102(b) as being unpatentable over Jannson in view of U.S. Patent No. 2,534,846 ("Ambrose"). Applicant respectfully traverses this rejection.

Appl. No. : 10/078,282  
Filed : February 19, 2002

**A. The Law of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. See *M.P.E.P.* § 2143. It is well settled that "a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'." See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000). The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fitch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

**B. Jannson and Ambrose, Each Alone or in Combination, Neither Teach nor Suggest all of the Limitations of Claims 40 and 46**

Claims 40 and 46 recite a combination of limitations including a primary and a secondary mirror which in a quiescent state is spaced on the primary mirror by a first distance so that light reflected from the modulator is of a first color, and which in a second state, under influence of a biased voltage is spaced from the primary mirror by a second distance which is less than the first distance so that the modulator reflects light of a second color. Thus, the primary mirror and the secondary mirror are separated by a first distance in one state, and by a second distance in a second state. Applicant respectfully submits that neither Jannson nor Ambrose teach or suggest the recited combination of limitations, including different separation distances when in different states. Jannson discloses that the spacer can be free space, see Jannson at col. 12, line 58, but indicates that the refractive index, not the spacing, of the material constituting the spacer changes according to voltage. See Jannson at col. 13, lines 4-11. Since neither Jannson nor Ambrose disclose or suggest all of the claim limitations, Applicant respectfully submits that the Office has

Appl. No. : 10/078,282  
Filed : February 19, 2002

failed to establish a *prima facie* case of obviousness. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection.

**Allowable Subject Matter**

Applicant appreciates the indication of allowable subject matter for Claims 41-45 and 47-51. Because independent Claims 40 and 46 are respectfully urged as allowable for the reasons discussed above, Applicant continues to request consideration of Claims 41-45 and 47-51 in dependent form at this time.

**Conclusion**

Applicant respectfully submits that this application is in condition for allowance, early notification of which would be appreciated. The Office is respectfully invited to contact the undersigned at the telephone number provided below with any questions regarding this application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 27, 2004

By: 

Mark M. Abumeri  
Registration No. 43,458  
Customer No. 20,995  
(619) 335-8550

S:\DOCS\JOM\JOM-6683.DOC  
102704